

MAR 14 2005

Express Mail Label No.: EV458034692US

2176
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17243-00043

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Leymaster et al.

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Art Unit: 2176

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Examiner: Quoc A Tran

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Serial No.: 10/092,101

Filed: March 6, 2002

For: METHODS AND SYSTEMS
FOR GENERATING
DOCUMENTS

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RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
Mail Stop AMENDMENT
Washington, D.C. 20231

Sir:

The Office Action mailed February 23, 2005 has been carefully reviewed and the following remarks have been submitted in consequence thereof. In response to the election requirement set forth in the Office Action, Applicants elect, with traverse, for prosecution in this application all claims of Group I as identified in the Office Action. Claims 1-11 and 20-32, drawn to document processing included compound document feature, are in the elected claim group.

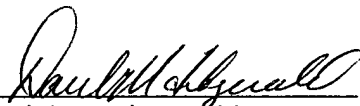
Reconsideration of the restriction requirement imposed under 35 U.S.C. § 121 is respectfully requested. The restriction requirement is traversed because the inventions set out by the claims in Groups I, II and III are clearly related. Applicants submit that a thorough search and examination of any of these claim groups would be relevant to the examination of the other groups and would not be a serious burden on the Examiner. Indeed, the claims of Group I, Group II and Group III are encompassed by a single class (Class 715), and it is not evident how the searching of a single class could present an unreasonable burden on the Examiner. Because the claims in Groups I, II and III are encompassed by a single class, the assertion that the claim groups have acquired a separate status in the art because of their recognized divergent subject

matter is respectfully traversed and submitted to be unsupportable on the present record. Therefore, to the extent that the restriction requirement relies on this assertion, it is respectfully submitted that the restriction requirement is improper and should be withdrawn.

The restriction requirement with respect to the claims in Groups I, II and III is further traversed. Applicants submit that the Office Action has not shown that the claims of Group I are patentably distinct from the claims of Group II or the claims of Group III. Particularly, the Office Action has not shown that the claims of Groups I, II or III recite "two or more claimed subcombinations, disclosed as usable together in a single combination, and which can be shown to be separately usable" as required by MPEP § 806.05(d). Rather, the Office Action merely asserts that "invention (I) has separate utility such as compound document; invention (II) has separate utility such as structure document; invention (III) has separate utility such as version management". Applicants, however, respectfully submit that the claims of Groups I and II are directed to a "document assembly production system" and the claims of Group III are directed to a "document assembly authoring system" and a "method for assembling output documents". Applicants therefore respectfully submit that the claims of Group I are not patentably distinct from the claims of Group II or the claims of Group III. Accordingly, Applicants submit that the restriction requirement is improper and reconsideration of the election requirement is requested.

In addition, requirements for restriction are not mandatory under 35 U.S.C. Accordingly, reconsideration of the restriction requirement is requested.

Respectfully Submitted,


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Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL

1. Transmitted herewith is:
Transmittal (3 pgs., in duplicate); Amendment in response to Office Action dated February 23, 2005 (2 pgs.); Return post card

STATUS

2. Applicant

☐
☒

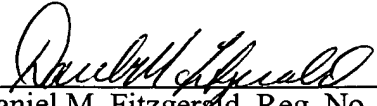
claims small entity status.
is other than a small entity.

**CERTIFICATE OF MAILING BY EXPRESS MAIL TO
THE COMMISSIONER FOR PATENTS**

Express Mail Label No.: EV458034692US

Date: March 11, 2005

I hereby certify that the documents listed above are being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. §1.10 on the date indicated above in an envelope addressed to Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.


Daniel M. Fitzgerald, Reg. No. 38,880

EXTENSION OF TERM

3. The proceedings herein are for a patent application and the provisions of 37 C.F.R. 1.136 apply.

(complete (a) or (b), as applicable)

- (a) ☐ Applicant petitions for an extension of time under 37 C.F.R. 1.136
(Fees: 37 C.F.R. 1.17(a)-(d) for the total number of months checked below:)

Extension for response within:	Other than small entity Fee	Small entity Fee (if applicable)
<input type="checkbox"/> first month	\$ 120.00	\$ 60.00
<input type="checkbox"/> second month	\$ 450.00	\$ 225.00
<input type="checkbox"/> third month	\$ 1,020.00	\$ 510.00
<input type="checkbox"/> fourth month	\$ 1,590.00	\$ 795.00
<input type="checkbox"/> fifth month	\$ 2,160.00	\$1,080.00
	Fee Due	\$

If an additional extension of time is required, please consider this a petition therefor.

(Check and complete the next item, if applicable)

- ☐ An extension of _____ months has already been secured. The fee paid therefor \$_____ is deducted from the total fee due for the total months of extension now requested.

Extension fee due with this request \$

OR

- (b) ☒ Applicant believes that no extension of term is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition for extension of time.

FEE FOR CLAIMS

4. The fee for claims (37 C.F.R. 1.16(b)-(d)) has been calculated as shown below:

	(Col. 1)		(Col. 2)	(Col. 3)	SMALL ENTITY		OTHER THAN SMALL ENTITY
	CLAIMS REMAINING AFTER AMENDMENT		HIGHEST NO. PREVIOUSLY PAID FOR	PRESENT EXTRA	ADDITIONAL RATE FEE	OR	ADDITIONAL RATE FEE
TOTAL		MINUS		=	x \$9 = \$		x \$18 = \$0.00
INDEP.		MINUS		=	x \$44 = \$		x \$88 = \$0.00
— FIRST PRESENTATION OF MULTIPLE DEP. CLAIM					+ \$150 = \$		+ \$300 = \$
					TOTAL ADDITIONAL FEE \$	OR	TOTAL ADDITIONAL FEE \$

- (a) ☒ No additional fee for Claims is required

OR

- (b) ☐ Total additional fee for claims required \$

FEE PAYMENT

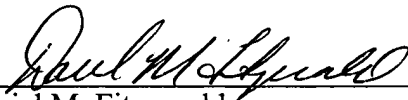
5. Attached is a check in the sum of \$
☐ Charge Deposit Account No. 01-2384 the sum of \$
A duplicate of this transmittal is attached.

FEE DEFICIENCY

6. ☒ If any additional extension and/or fee is required, charge Deposit Account No. 01-2384.

AND/OR

- ☒ If any additional fee for claims is required, charge Deposit Account No. 01-2384.
7. ☐ Other:



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